

REMARKS

Claim Rejections

Claims 1-6 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yu (U.S. 6,561,421) in view of Chao (U.S. 6,773,192).

Drawings

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

New Claims

By this Amendment, Applicant has canceled claims 1-6 and has added new claims 7-15 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a pen for use with an IC card (3) comprising: a pen tube (1) with a pen tip (11); a detachable tube (2) having: a slit (23) located through a peripheral wall; a clip (24) rotatably attached to a first end thereof and selectively covering the slit; and a cap (25) removably connected to the first end of the detachable tube; and a connector (21) located between and connecting the pen tube and the detachable tube, the connector having: a terminal plug (211); and a card insert slot (212) aligning with the slit of the detachable tube, wherein the IC card is removably inserted through the slit and into the card insert slot.

Other embodiments of the present invention include: the terminal plug is one of a USB plug and a 1394 firewire plug; the IC Card is selected from a group of IC cards consisting of a SIM card, a SD card, a MMC card, a memory stick, a compact flash card, an XD card, a PCMCIA card, and a Smart Media card; the terminal plug is located on a top of the connector; the terminal plug is located on a bottom of the

connector; the IC card is a wireless data transmission device; the connector includes a locking ring (22) located on an outer periphery thereof, the locking ring is located between the pen tube and the detachable tube; the cap is threadedly connected to the first end of the detachable tube; and the connector is threadedly connected to the first end of the pen tube.

The primary reference to Yu teaches a universal serial bus card reader having a main body (3) having a USB plug (31) and an inserting slot (32) located on an electronic circuit (33), and a cover (4).

Yu does not teach a pen tube with a pen tip; a detachable tube having a slit located through a peripheral wall; a detachable tube having a clip rotatably attached to a first end thereof and selectively covering the slit; a detachable tube having a cap removably connected to the first end of the detachable tube; a connector located between and connecting the pen tube and the detachable tube; the connector having a card insert slot aligning with the slit of the detachable tube; the IC card is removably inserted through the slit and into the card insert slot; nor does Yu teach the terminal plug is located on a top of the connector.

The secondary reference to Chao teaches a light-emitting USB mobile desk pen having an upper pen shaft (2) with a bulb (22), a lower pen shaft (1) with a refill (4), and a sheathe with a USB plug (7) and a PCB (8).

Chao does not teach a detachable tube having a slit located through a peripheral wall; a detachable tube having a clip rotatably attached to a first end thereof and selectively covering the slit; a detachable tube having a cap removably connected to the first end of the detachable tube; the connector having a card insert slot aligning with the slit of the detachable tube; the IC card is removably inserted through the slit and into the card insert slot; nor does Chao teach the terminal plug is located on a top of the connector.

Even if the teachings of Yu and Chao were combined, as suggested by the Examiner, the resultant combination does not suggest: a detachable tube having a slit located through a peripheral wall; a detachable tube having a clip rotatably attached to a first end thereof and selectively covering the slit; a detachable tube having a cap removably connected to the first end of the detachable tube; the connector having a card insert slot aligning with the slit of the detachable tube; the

IC card is removably inserted through the slit and into the cart insert slot; nor does the combination suggest the terminal plug is located on a top of the connector.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning

quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Yu or Chao that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Yu nor Chao disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

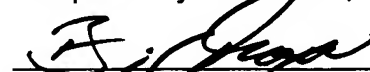
Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Date: January 5, 2005

By:

Respectfully submitted,



Bruce H. Troxell

Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707